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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	694231/0051 JJD:IGD	5110
32361	7590	11/22/2005	EXAMINER	
GREENBERG TRAURIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/696,295	MORRISROE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James W. Myhre	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 17 October 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 and 31-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on October 17, 2005 under 37 CFR 1.111 has been considered but is ineffective to overcome the Reilly et al (5,740,549) reference. The amendment cancelled Claim 30 and both of the claims previously numbered as Claim 29 and reintroduced them as new Claims 31-33. Therefore, the currently pending claims considered below are Claims 1-28 and 31-33.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (5,740,549).

Claims 1, 11, 12, 16, 24, 25, and 33: Reilly discloses a method for providing an advertisement over a network comprising:

a. Identifying a plurality of files, including one with at least one placeholder (insertion point) therein (col 5, line 47 – col 6, line 10 and col 8, lines 50-53);

- b. Combining an advertisement file with a conduit file (display script) to create an integrated advertisement file containing the advertisement content and the tracking data (col 5, line 47 – col 6, line 10 and col 8, lines 50-53);
- c. Serving (transmitting) the integrated advertisement file to a client computer (e.g. consumer's computer)(col 5, line 47 – col 6, line 10).

While Reilly does not explicitly disclose that the advertisement file and the conduit file are combined into a transmission file prior to transmission to the client computer, the cited passage discloses that the transmission will include a plurality of objects, such as information items, advertisements, display scripts, update data, upgrade data, etc. It is well known to combine such objects into a single transmission file (package) for transmission over a network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the conduit file with the advertisement file to which it pertained and to transmit the combined transmission file (integrated advertisement file). One would have been motivated to combine these files in this manner in order to enable the client computer to more easily identify the correlation between the files and in order to facilitate time efficient transmissions as discussed by Reilly and noted by the Applicant (page 12).

Claims 2, 3, 13, 14, 22, 23, and 28: Reilly discloses a method for providing an advertisement over a network as in Claims 1, 12, 16, and 25 above, and further discloses receiving modified advertisement and conduit files and updating the client

computer to reflect the updated information (col 5, line 47 – col 6, line 10 and col 8, lines 24-31).

Claims 4 and 26: Reilly discloses a method for providing an advertisement over a network as in Claims 1 and 25 above, but does not explicitly disclose the file type or programming language in which the advertisement is written. However, such decisions of file type and programming language are management decisions based on such factors as the capability of the system hardware and the capability and familiarity of the computer programmer with files types and programming languages. Since Flash ads and .swf files were both known prior to the filing date of this application, they would have been among the obvious choices for the system designer from which to choose when setting up the system.

Claims 5, 6, 15, 17, and 27: Reilly discloses a method for providing an advertisement over a network as in Claims 1, 11, 16, and 26 above, and further discloses that the advertisement file can include an animated sprite generator used to simulate motion (i.e. movie clip object). While it is not explicitly disclosed that the conduit file will be inserted into this empty movie clip object, the Examiner notes that since the conduit file contains tracking data (according to Claim 1), not a movie clip, once the conduit file is inserted into an appropriate area (object) within the advertisement file, such as the claimed empty movie clip object, that area is no longer an empty movie clip object but is the conduit file object. Thus, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to insert the conduit file into any appropriate "empty" space or object within the advertisement file. One would have been motivated to use the empty movie clip object in view of the fact that it was empty space which was not being used for anything else in the claimed invention.

Claims 7-9, 18, 19, 31, and 32: Reilly discloses a method for providing an advertisement over a network as in Claims 1 and 16 above, and further discloses linking to one or more webpages (displayed either in the same window or in another window) when the user clicks on a button, the advertisement, or any other linking object on the screen (col 13, lines 3-25). The Examiner notes that html codes, URLs, JavaScript files, and links are normal parts of webpages and links and are suggested by Reilly's disclosure of the World Wide Web. A more detailed description of the Internet, the World Wide Web, HTML, URLs, web pages, and links can be found in the Background of the Invention section (columns 1-3) of the Levergood et al (5,708,780) reference listed in the Conclusion section in the previous Office Action.

Claim 10: Reilly discloses a method for providing an advertisement over a network as in Claim 1, and further discloses including a tracking identifier for tracking the advertisement (col 9, lines 18-33 and col 11, lines 64-66).

Claims 20 and 21: Reilly discloses a method for providing an advertisement over a network as in Claim 16 above, and further discloses using a web-based executable program (application) to perform the steps of the invention (col 4, lines 23-38).

### ***Response to Arguments***

4. Applicant's arguments filed October 17, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claim 1 that Reilly does not disclose serving an integrated ad file that contains an ad input file and a conduit file (pages 11-12) and further argues against the Official Notice taken about combining files into "batch" files prior to transmission over a network (page 12). The Examiner first notes that the claimed "integrated ad file" according to the claims and Applicant's arguments consists of at least two files - - an ad input file and a conduit file. While the Applicant is calling it a file, it is better known in the hierarchical files system art as a folder, which is "a means of organizing programs and documents on a disk and can hold both files and additional folders" (Microsoft Press Computer Dictionary, Third Edition, pages 202-203). A folder, along with the files it contains, may be directly transmitted over networks or may be attached to another transmission means, such as an e-mail message. Thus, Reilly's disclosure of simultaneously sending a plurality of files over the network to the user's computer and his disclosure of using compression to decrease the transmission time would have suggested to one having even rudimentary skill in the art placing the

separate files in one folder (integrated ad file) and compressing it (such as generating a .zip file) to form a transmission file prior to the transmission.

b. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present instance, the combination of two or more files into a folder (integrated file) was very well known in the art at the time of the invention and would have been an obvious method of transmitting the plurality of files in Reilly, even to a person with only rudimentary skill in the art.

c. The Applicant argues in reference to Claim 11 that Reilly does not disclose identifying a placeholder in the first file where the second file is to be inserted to create the ad file (pages 15-16). The Examiner notes that Reilly discloses display scripts which control which part of the screen will display the new items and which part will display the advertisements (col 9, line 65 – col 10, line18) and that "A portion of the data view screen is always occupied by an advertisement image 258." (col 13, lines 61-64). Reilly further discloses that the news items, the advertisements, and the display scripts are all downloaded at the same time. The Examiner considers the portion of the display

script which identifies the location on the display screen where the advertisement is to be inserted as the equivalent of the claimed "placeholder".

d. As to the Applicant's statement that "pointing out by drawing, reference number and paragraph citation the specific elements of Reilly" are new grounds for rejection and should be made non-final, the Examiner notes that the rejection is based on the entire reference and not just on the portions referenced in the rejection. Such citations are made for the convenience of the Applicant only. It is the Applicant's responsibility to read and considered all teachings within the reference, not only those cited by the Examiner. The above rejection is still made using the same reference and common knowledge; thus, it is not considered to be a new grounds of rejection. Therefore, it is proper to make this action a Final Rejection as indicated below.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

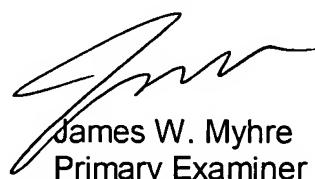
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM  
November 15, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622